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EXAMINER

KAU, STEVEN Y

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2625

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/573,334	HAMASHIMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	STEVEN KAU	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 25 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>IDS</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This is the initial office action based on the application 371(c) filing date, April 25, 2006.

#### ***Preliminary Amendment***

2. Applicants filed a preliminary amendment on March 24, 2006 and Page 1 of the specification has been amended to include "This application is a U. S. National Phase Application of PCT International Application PCT/JP2004/013799 filed on September 22, 2004".

Claims 1-36 are pending for further examination in this Action.

#### ***Information Disclosure Statement***

3. The information disclosure statements (IDS) submitted on 4/14/2009, 2/20/2009, 1/16/2009, 1/06/2009, 9/28/2008, 9/08/2008, 6/25/2008, 6/05/2008, 5/16/2008, and 3/24/2006 are in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statements are being considered by the examiner.

#### ***Priority***

4. Acknowledgment is made of applicant's claim for PCT filing data of September 22, 2004. Acknowledgment is made of applicant's claim for foreign priority under 35

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U.S.C. 119(b)/PCT Rule 17. The certified copy has been filed in parent Application NO. 10/573,334 on March 24, 2006.

### ***Joint Inventorship***

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicants are advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 14-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claim 14, limitation recites, "input element for inputting an image data from a recording medium by a reading device provided for each recording medium type", (emphasis added by the examiner). The underlined phrase renders indefinite of recording medium type. For example, one ordinary skill in the art does not know which recording medium type that applicants are claiming as their invention. In light of the specification, the examiner will give a reasonable broadest

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interpretation for this limitation. Claims 15-18 are dependent claims to claim 14 and are rejected under 35 U.S.C. 112, second paragraph because of their dependency to claim 14.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 30, 31, 32, 33 and 34 are rejected under 35 U.S.C. 101 as not falling within one of the four statutory categories of invention. Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions<sup>2</sup> indicate that a statutory “process” under 35 U.S.C. 101 must (1) be tied to another statutory category (such as a particular apparatus), or (2) transform underlying subject matter (such as an article or material) to a different state or thing. While the instant claims recite a series of steps or acts to be performed, the claim(s) neither transform underlying subject matter nor positively tie to another statutory category that accomplishes the claimed method steps, and therefore do not qualify as a statutory process. For example, Claim 6 is directed to an image correction method, steps recite, “an image correction value holding of holding an image correction value for each pattern in a memory device; and an image correction of retrieving from

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<sup>1</sup> *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

<sup>2</sup> *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

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the memory device an image correction value corresponding to the designated pattern, correcting the image data, and displaying the corrected image data.” The applicant has not provided explicit and deliberate definitions of which particular apparatus is used for image correction, i.e. executing steps of “an image correction value holding of holding an image correction value for each pattern in a memory device”, and “an image correction of retrieving from the memory device an image correction value corresponding to the designated pattern, correcting the image data, and displaying the corrected image data”, etc., or to limit the steps of “an image correction value holding of holding an image correction value for each pattern in a memory device”, and “an image correction of retrieving from the memory device an image correction value corresponding to the designated pattern, correcting the image data, and displaying the corrected image data”, etc., for transforming underlying subject matter (such as an article or material) to a different state or thing. Thus, the method of image correction would be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine, i.e. a set of algorithm or a set of procedures without a machine for execution. Claims 31-34 are rejected under 35 U.S.C. 101 for the same reasons discussed above in the rejection of claim 30.

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***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

11. Claims 1-7, and 35-56 are rejected under 35 U.S.C. 102(e) as being anticipated by Nardozzi et al (US 6,636,837).

Regarding claim 1.

Nardozzi discloses An image output apparatus comprising:  
input element for inputting an image data (**i.e. Apparatus 10 of Fig. 1 has a communication connection allowing customer to download images from a memory card for image process, col 5, line 60 to col 6, line 4**); output element for printing out the image data (**i.e. referring to Fig. 2, photofinishing lab is set to process films and to produce prints for customers, col 6, line 17-32**); and setting element for performing setting in relation to whether or not attribute information held by the image data is used (**i.e. setting elements per customer's requirements, i.e. types of formats such CDs or enlargements of existing prints, col 6, lines 17-32**).

Regarding claim 2, in accordance with claim 1.

Nardozzi discloses wherein when use of the attribute information is set, the listing sequence of the image data is determined on the basis of date and time information contained in the attribute information; and when use of the attribute information is not set, the listing sequence of the image data is determined on the basis of the date and time of creation or the date and time of update of the image data (**i.e. referring to Figs. 4a & 4b, each customer's order is associated with image attributes, i.e. type of image such prints or CDs, etc., and due date are included in the label, col 7, lines 28-51).**

Regarding claim 35, in accordance with claim 1.

Nardozzi discloses a program which causes a computer to function as the image output apparatus according to claim 1 (**i.e. "a computer software program for programming the computer so that a plurality of the photofinishing goods and/or services will be displayed on the display device", col 2, lines 54-61).**

Regarding claim 36, in accordance with claim 1.

Nardozzi discloses a recording medium on which is recorded a program which causes a computer to function as the image output apparatus according to claim 1 (**i.e. loading a computer software program on to the computer of Fig. 1, it implies that the computer software program is recorded or stored in a computer-readable medium, i.e. a disk, col 3, lines 34-49).**

Regarding claim 3.

Nardozzi discloses An image output apparatus comprising: input element for inputting an image data (**i.e. Apparatus 10 of Fig. 1 has a communication**



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**connection allowing customer to download images from a memory card for image process, col 5, line 60 to col 6, line 4);** output element for printing out the image data (i.e. referring to Fig. 2, photofinishing lab is set to process films and to produce prints for customers, col 6, line 17-32); and setting element for performing setting in relation to subjects of a batch instruction (i.e. referring to Fig. 2, Nardozzi discloses a central image process Lab which collects image from a plurality of Kiosk and to process image to produce prints; this implies that a collective instruction, or a batch instruction must be applied in order to produce photofinishing goods, i.e. prints, CDs and or T-shirts, col 6, lines 17-58).

Regarding claim 4, in accordance with claim 3.

Nardozzi discloses wherein the subjects of the batch instruction are only displayed image data or all the image data (i.e. referring to Figs 1 and 2, Nardozzi discloses Apparatus 10 for different Kiosk location in the city, state or regions of a country and a central photofinishing Lab; thus, collective instruction or a batch instruction must be applied for processing different type of images, i.e. CDs or produce prints, col 6, lines 17-58).

Regarding claim 5.

Nardozzi discloses An image output apparatus comprising: input element for inputting an image data (i.e. Apparatus 10 of Fig. 1 has a communication connection allowing customer to download images from a memory card for image process, col 5, line 60 to col 6, line 4); output element for printing out the image data (i.e. referring to Fig. 2, photofinishing lab is set to process films and to produce

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**prints for customers, col 6, line 17-32); and setting element for performing setting in relation to charging display (i.e. referring to Fig. 1, Apparatus 10 has a credit card opening for a customer to pay for the service, col 5, lines 32-41).**

Regarding claim 6, in accordance with claim 5.

Nardozzi discloses wherein the setting for the charging display includes at least one of a tax rate, a taxation method, and presence/absence of tax amount display **(referring to Fig. 1, Apparatus 10 has a display for displaying information as well as an input device, and credit card opening for customers to insert a credit card to pay for the service; thus, total amount for the service and tax information must be displayed so that a customer will know how much he or she is responsible for the payment, col 5, lines 32-41).**

Regarding claim 7.

Nardozzi discloses An image output apparatus comprising:  
input element for inputting an image data **(i.e. Apparatus 10 of Fig. 1 has a communication connection allowing customer to download images from a memory card for image process, col 5, line 60 to col 6, line 4);** output element for printing out the image data **(i.e. referring to Fig. 2, photofinishing lab is set to process films and to produce prints for customers, col 6, line 17-32);** and enlarged display setting element for performing setting in relation to whether or not a reduced image data is enlarged and displayed during a transition from a simplified image display based on the reduced image data to a detailed image display based on actual image data **(i.e. Nardozzi discloses a central photofinishing lab and apparatus 10 used in**

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**different Kiosk location to process images ordered by customers including producing prints and image enlargements, col 6, lines 17-32).**

12. Claims 8, 9, 14-18, 20-25, 28, 30 and 33 are rejected under 35 U.S.C. 102(e) as being as being anticipated by Testa et al (US 6,745,186).

Regarding claim 8.

Testa discloses an image output apparatus comprising: input element for inputting an image data (**i.e. the image is obtained from scanning in from films, photographic prints, etc., Fig. 1, col 4, lines 10-21, & col 13, lines 54-60**); output element for printing out the image data (**i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50**); and resolution setting element for setting the resolution of a display device which displays the image data (**i.e. referring to Fig. 22, system 330 has a computer with a display monitor for image manipulation, i.e. color correction and resolution, col 14, lines 31-53**).

Regarding claim 9.

Testa discloses an image output apparatus comprising:  
input element for inputting an image data (**i.e. the image is obtained from scanning in from films, photographic prints, etc., Fig. 1, col 4, lines 10-21, & col 13, lines 54-60**); output element for printing out the image data (**i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50**);  
image correction value holding element for holding in a memory device an image

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correction value for each pattern (i.e. referring to Fig. 22, system 330 has a **computer with a display monitor and memory, i.e. a hard disk for image manipulation, i.e. color correction and pattern size, col 14, lines 31-53**); and image correction element for retrieving the image correction value corresponding to a designated pattern from the memory device, correcting the image data, and displaying the corrected image data (**as discussed above, system 330 of Fig. 22 includes a computer for image manipulation including color correction, sharpness & resolution control, image retrieving and patterns selection, or designation, etc., col 14, lines 31-53 and col 15, line 65 to col 16, line 16**).

Regarding claim 30.

Claim 30 is directed to a method claim which substantially corresponds to operation of the device in claim 9, with method steps directly corresponding to the function of device elements in claim 9. Thus, claim 30 is rejected as set forth above for claim 9.

Regarding claim 14.

Testa discloses an image output apparatus comprising:  
input element for inputting an image data from a recording medium by a reading device provided for each recording medium type (**referring to Figs. 1 and 22, as a second image source, image data from a computer disk, photo CD or a digital camera can be read or input form the computer 329 of Fig. 22, col 4, lines 11-21**); output element for printing out the image data (**i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50**); selection

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element for selecting a recording medium type (**i.e. having a second image input source, i.e. computer disk, photo CD or a digital camera, operator of the system 330 must select a recording medium in accordance with customer's order and requirements, col 4, lines 40-50**); and switching element for switching the reading device according to the selected recording medium type (**i.e. it is an inherent property of system 330 of Fig. 22 that the central computer must have a switching element for a recording medium, i.e. a photo CD to insert in for obtaining image data and to process the data which customer ordered, col 4, lines 40-50**).

Regarding claim 15, in accordance with claim 14.

Testa discloses wherein the switching element drives at least one of a cover plate which has one hole and is provided in front of the insertion opening of each reading device and a support member for supporting each reading device integrally, such that the insertion opening of the reading device corresponding to the recording medium type is placed at the position of the hole (**referring to Fig. 22, central computer 342 has capability to obtain image data from a second image input source, i.e. photo CD or computer disk; it is an inherent property that the central computer must have an insertion opening to allow a disk or a photo CD to insert in, and the computer must have a reading device to read image data for processing, and the reading device must be supported integrally, etc., col 4, lines 40-50**).

Regarding claim 16, in accordance with claim 14.

Regarding claim 16, recites identical features as claim 15. Thus, arguments similar to that presented above for claim 15 are also equally applicable to claim 16.

Regarding claim 17, in accordance with claim 14.

Testa discloses recording medium detecting device for detecting the shape of the recording medium or identification information attached to the recording medium, wherein the selection element determines the type of the recording medium on the basis of recording medium determination information which relates the shape or the identification information to the type of the recording medium (**Giving the fact that the central computer of Fig. 22 has the capability to obtain image data from a second image input resource, i.e. photo CD, computer disk, or a digital camera; thus the central computer must also capable to detect the type of the recording medium based on the identification and or the shape, i.e. computer disk has different shape than a photo CD, to process image data, col 4, lines 40-50**).

Regarding claim 18, in accordance with claim 14.

Regarding claim 18, recites identical features as claim 17. Thus, arguments similar to that presented above for claim 17 are also equally applicable to claim 18.

Regarding claim 33.

Claim 33 is directed to a method claim which substantially corresponds to operation of the device in claim 14, with method steps directly corresponding to the function of device elements in claim 14. Thus, claim 33 is rejected as set forth above for claim 14.

Regarding claim 20.

Testa discloses an image output apparatus having a supplementary memory device, comprising:  
input element for inputting an image data (**i.e. the image is obtained from scanning in from films, photographic prints, etc., Fig. 1, col 4, lines 10-21, & col 13, lines 54-60**); printout element for printing the image data (**i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50**); and holding element for holding the image data in the supplementary memory device (**i.e. image data is hold in the supplemental memory, i.e. photo CD, computer disk, or a digital camera, col 4, lines 40-50**).

Regarding claim 21, in accordance with claim 20.

Testa discloses wherein the input element is recording medium reading-input element for reading and inputting the image data from the recording medium or reception-input element for receiving and inputting the image data via a network (**referring to Fig. 22, central computer 342 has capability to obtain image data from a second image input source, i.e. photo CD or computer disk, col 4, lines 40-50 and customer can download the captured image through internet to a kiosk for placing an order, col 16, lines 35-45**).

Regarding claim 22, in accordance with claim 20.

Testa discloses wherein the image data held by the holding element is printed out (**i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50**).

Regarding claim 23, in accordance with claim 20.

Regarding claim 23, recites identical features as claim 20. Thus, arguments similar to that presented above for claim 20 are also equally applicable to claim 23.

Regarding claim 24, in accordance with claim 23.

Testa discloses wherein the print-related information indicates whether or not the image data to be printed is held (**i.e. referring to Fig. 4, print-related or order-related information indicates upload the image to an e-mail storage account; that is, indicating the print-related information is to be stored or held, col 6, lines 50-68**).

Regarding claim 25, in accordance with claim 20.

Testa discloses wherein the supplementary memory device is a hard disk unit built into the image output apparatus (**referring to Fig. 22, the central computer must have a hard drive for storing images being processed, col 13, lines 30-67**).

Regarding claim 28, in accordance with claim 20.

Testa discloses wherein the image data are stored with user authentication information, and the image data is printed or deleted in accordance with the user authentication information entered by a user (**i.e. order information from customers are scanned and stored in the image processing apparatus and the order information includes customer, or user authentication information, i.e. personal information for image processing, i.e. printing, col 6, lines 50-67**).

### ***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:



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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 10 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Testa et al (US 6,745,186) in view of Groezinger (US 5,115,477).

Regarding claim 10.

Testa discloses an image output apparatus comprising:  
input element for inputting an image data (**i.e. the image is obtained from scanning in from films, photographic prints, etc., Fig. 1, col 4, lines 10-21, & col 13, lines 54-60**); output element for printing out the image data (**i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50**).

Testa does not teach reference pixel designation element for designating a reference pixel to be achromatic; element for calculating the difference between the color data of the reference pixel and achromatic data; and image adjustment element for performing image adjustment on the entire image data based on the difference and for displaying the adjusted image data.

Groezinger teaches reference pixel designation element for designating a reference pixel to be achromatic (**i.e. determining gray scale values or achromatic value of reference pixels, col 5, lines 14-34**); element for calculating the difference between the color data of the reference pixel and achromatic data (**referring to Fig. 2, a process for calculating the gray scale value difference, col 5, lines 14-34**); and image adjustment element for performing image adjustment on the entire image data

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based on the difference and for displaying the adjusted image data (**i.e. producing higher resolution and more precise image of the object of interest requires image adjustment on the entire image data, col 2, lines 39-44**).

Having an image output apparatus of Testa' 186 reference and then given the well-established teaching of Groezinger' 477 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image output apparatus of Testa' 186 reference to include reference pixel designation element for designating a reference pixel to be achromatic; element for calculating the difference between the color data of the reference pixel and achromatic data; and image adjustment element for performing image adjustment on the entire image data based on the difference and for displaying the adjusted image data as taught by Groezinger' 477. The motivation for doing so would have been to enhance the apparatus to produce higher resolution and more precise image of the object of interest, and further the services provided could easily be established for one another with predictable results.

Regarding claim 31.

Claim 31 is directed to a method claim which substantially corresponds to operation of the device in claim 10, with method steps directly corresponding to the function of device elements in claim 10. Thus, claim 31 is rejected as set forth above for claim 10.

15. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Testa et al (US 6,745,186) in view of Sasaki et al (US 6,195,470).

Regarding claim 11.

Testa discloses an image output apparatus comprising: input element for inputting an image data; **(i.e. the image is obtained from scanning in from films, photographic prints, etc., Fig. 1, col 4, lines 10-21, & col 13, lines 54-60)**; output element for printing out the image data **(i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50)**; processing element for processing the image data **(i.e. system 330 for image processing, i.e. color correction, etc., col 14, lines 31-53)**.

Testa does not teach that origin point setting element for setting, for the image data, at least one of a point of origin for rotation, a point of origin for an inversion process, a point of origin for an enlargement process, and a point of origin for a reduction process.

Sasaki teaches that origin point setting element for setting, for the image data, at least one of a point of origin for rotation **(referring to Fig. 18, rotating the point clockwise about the origin, col 22, lines 5-10)**, a point of origin for an inversion process **(referring to Fig. 23, in verse matrix of the transformation matrix at point A, col 26, lines 38-55)**, a point of origin for an enlargement process, and a point of origin for a reduction process **(referring to Fig. 6a-6b, enlargement/reduction transformation in one coordinate system, col 9, lines 27-47)**.

Having an image output apparatus of Testa' 186 reference and then given the well-established teaching of Sasaki' 470 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image

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output apparatus of Testa' 186 reference to include that origin point setting element for setting, for the image data, at least one of a point of origin for rotation, a point of origin for an inversion process, a point of origin for an enlargement process, and a point of origin for a reduction process as taught by Sasaki' 470. The motivation for doing so would have been to enhance the apparatus to produce higher resolution and more precise image of the object of interest including image rotation, enlargement/reduction, etc., and further the services provided could easily be established for one another with predictable results.

16. Claims 12, 13 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Testa et al (US 6,745,186) in view of Suzuki (US 5,412,451).

Regarding claim 13.

Testa discloses an image output apparatus comprising: input element for inputting an image data; **(i.e. the image is obtained from scanning in from films, photographic prints, etc., Fig. 1, col 4, lines 10-21, & col 13, lines 54-60)**; output element for printing out the image data **(i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50)**; and processing element for processing the image data **(i.e. system 330 for image processing, i.e. color correction, etc., col 14, lines 31-53)**.

Testa does not teach wherein the image data can be moved within a range in which at least a part of the image data is present within a printout area.

Suzuki teaches moving element for moving the image data to a position wherein at least a part of the image data is present within a printout area, when the entire image data goes over the printout area (**i.e. film is moved in a direction and detection of frame position for printing within a print out area, col 9, line 60 to col 10 line 9**).

Having an image output apparatus of Testa' 186 reference and then given the well-established teaching of Suzuki' 451 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image output apparatus of Testa' 186 reference to include moving element for moving the image data to a position wherein at least a part of the image data is present within a printout area, when the entire image data goes over the printout area as taught by Suzuki' 451. The motivation for doing so would have been to enhance the apparatus to produce more precise image of the object of interest including image rotation, and further the services provided could easily be established for one another with predictable results.

Regarding claim 12.

Claim 12 is directed to an image output apparatus claim which substantially corresponds to the operation of the device in claim 13, with identical features corresponding directly to the function of device elements in claim 3. Thus claim 12 is rejected as set forth above for claim 13.

Regarding claim 32.

Claim 32 is directed to a method claim which substantially corresponds to operation of the device in claim 13, with method steps directly corresponding to the

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function of device elements in claim 13. Thus, claim 32 is rejected as set forth above for claim 13.

17. Claims 19 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Testa et al (US 6,745,186) in view of Matsuo et al (US 2003/0076399) and further in view of Kato et al (US 5,561,535)

Regarding claim 19.

**(referring to Figs. 1 and 22, as a second image source, image data from a computer disk, photo CD or a digital camera can be read or input from the computer 329 of Fig. 22, col 4, lines 11-21); output element for printing out the image data (i.e. output of images or services can be reprints, photo-album pages, T-shirts, and CDs, etc., col 4, lines 40-50); detection element for detecting the size of the recording medium (i.e. referring to Fig. 22, central computer can detect recording medium size and it is well known in the art, col 4, lines 40-50).**

Testa does not teach that warning element for giving off a warning when a recording medium which is smaller than the size of the insertion opening is detected in the vicinity of the insertion opening of the reading device.

Matsuo teaches when a recording medium which is smaller than the size of the insertion opening is detected in the vicinity of the insertion opening of the reading device **(i.e. size detector detects the size of recording medium; Par. 62);** and

Katoh teaches that warning element for giving off a warning (**i.e. warning indicates the necessary change the size of the input information, col 8, lines 54-64**).

Having an image output apparatus of Testa' 186 reference and then given the well-established teaching of Matsuo' 399 reference, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the image output apparatus of Testa' 186 reference to include moving element for moving the image data to a position wherein at least a part of the image data is present within a printout area, when the entire image data goes over the printout area as taught by Matsuo' 399 and to include that warning element giving off a warning as taught by Katoh' 535. The motivation for doing so would have been to enhance the apparatus to produce more precise image of the object of interest including image recording medium size detection, and further the services provided could easily be established for one another with predictable results.

Regarding claim 34.

Claim 34 is directed to a method claim which substantially corresponds to operation of the device in claim 19, with method steps directly corresponding to the function of device elements in claim 19. Thus, claim 34 is rejected as set forth above for claim 19.

18. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Testa et al (US 6,745,186) in view of Nash et al (US 2002/0109682)

Regarding claim 26, in accordance with claim 20.

Testa does not disclose wherein when the amount of the image data stored in the supplementary memory device exceeds a predetermined level, if necessary, the holding element sequentially deletes the held image data.

Nash teaches wherein when the amount of the image data stored in the supplementary memory device exceeds a predetermined level, if necessary, the holding element sequentially deletes the held image data (**i.e. memory is periodically determined if it exceeds its memory capacities and remove unwanted data to make room for other use, Par. 49**).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Testa to include wherein when the amount of the image data stored in the supplementary memory device exceeds a predetermined level, if necessary, the holding element sequentially deletes the held image data as taught by Nash. The motivation for doing so would have been to enhance the memory management for better efficiency for the image output apparatus, and further it is easily implemented by one or other in the art with a predictable result.

19. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Testa et al (US 6,745,186) in view of Yasuo (JP 10-226115).

Testa does not disclose wherein when the holding time of the image data stored in the supplementary memory device exceeds a predetermined holding period, if necessary, the holding element sequentially deletes the held image data.



Yasuo teaches wherein when the holding time of the image data stored in the supplementary memory device exceeds a predetermined holding period, if necessary, the holding element sequentially deletes the held image data (**i.e. bitmap data is deleted when the storage time is greater than a predetermined time period, Abstract, and Par. 5).**

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Testa to include wherein when the holding time of the image data stored in the supplementary memory device exceeds a predetermined holding period, if necessary, the holding element sequentially deletes the held image data as taught by Yasuo. The motivation for doing so would have been to enhance the memory management for better efficiency for the image output apparatus, and further it is easily implemented by one or other in the art with a predictable result.

20. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Testa et al (US 6,745,186) in view of Caldwell (US 2001/0034648).

Testa does not disclose wherein the user authentication information includes user identification information and password information.

Caldwell teaches wherein the user authentication information includes user identification information and password information (**i.e. photograph seeker, or user provides identification and password to authenticate his or her identity, Par. 78).**

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to have modified Testa to include wherein the user authentication

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information includes user identification information and password information as taught by Caldwell. The motivation for doing so would have been to enhance the security management for the image output apparatus, and further it is easily implemented by one or other in the art with a predictable result.

***Conclusion***

21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven Kau whose telephone number is 571-270-1120 and fax number is 571-270-2120. The examiner can normally be reached on M-F, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Moore can be reached on 571-272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Steven Kau/  
Examiner, Art Unit 2625  
June 9, 2009

/David K Moore/  
Supervisory Patent Examiner, Art Unit 2625